

REMARKS

Amended Claims

Claims 1, 11, 13 and 15 are amended herein. Claim 12 is cancelled.

Objected Claims

Claims 11 was objected to for having informalities. Specifically, the Examiner objected to “going offline” in line 2 of claim 11 and suggested “goes offline”. Claim 11 is amended herein as suggested by the Examiner to correct the informalities and overcome the objection. Applicant therefore respectfully requests withdrawal of the objection to claim 11.

Claim Rejections Under 35 U.S.C. § 112

Claims 11 and 13-20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejection.

Claim 11 has been amended to clarify the claim and overcome the rejection under 35 U.S.C. § 112, second paragraph. Specifically, claim 11 was amended to replace “it going offline” with “the network device goes offline”.

In regards to claims 13 and 15, the Examiner maintains that “It is unclear which imaging devices are considered ‘similar to’ other imaging devices.”

Claim 13 recites, in part, “communicating with the other similar imaging devices by referring to the list of network addresses for the other imaging devices.” Claim 15 recites, in part, “determining a list of network addresses for other imaging devices similar to the imaging device.” Applicant maintains that claims 13 and 15 refer to an imaging device storing a list of other imaging devices on the same network as the imaging device that have the same or compatible manufacturer, imaging device type, or features, and that such would be apparent to one skilled in the art. Applicant also respectfully maintains that “imaging devices similar to the imaging device” of claims 13 and 15 are described, at least, by Paragraph [0022] of the present Specification. In particular, the features of claims 13 and 15 of imaging devices similar to the imaging device are described as “imaging devices similar with regard to manufacturer, imaging device type, or features.” *See*, Specification of the Present Application, Paragraph [0022], Line 13. Applicant thus contends that relevant features of claims 13 and 15 are definite and are described in the specification to enable one

skilled in the art to practice the invention. Applicant also contends that, as claims 14 and 16-20 depend from and further define claims 13 and 15, they are also considered definite and enabled.

Applicant therefore respectfully requests that the rejection of claims 11 and 13-20 under 35 U.S.C. § 112, second paragraph, be withdrawn in that the claims are not indefinite and that the specification does clearly describe the invention in a way to enable one skilled in the art to make or use the invention.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 4, 6, 7, and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by DeKonig et al. (U.S. Patent No. 6,769,022). Applicant respectfully traverses this rejection. Applicant reserves the right to swear behind the reference DeKonig et al., but submits that claims 1, 4, 6, 7, and 9, as amended, are allowable for the following reasons.

Applicant respectfully maintains that DeKonig et al. discloses a system for managing storage devices on a network, having a management station 208 to execute and display management application programs. Applicant contends that a management station executing and displaying management application programs is not an imaging device having an image generator that is a print engine. *See*, DeKonig et al., Figure 2; Column 2, lines 6-63. Applicant therefore respectfully submits that DeKonig et al. fails to teach or disclose all elements of the Applicant's claimed invention.

Applicant's claim 1 recites "[a]n imaging device comprising an image generator, wherein the image generator is a print engine; a network interface; and a controller coupled to the network interface and the image generator, wherein the controller is adapted to store a list of other network addresses." As detailed above, Applicant submits that DeKonig et al. fails to teach or disclose such an imaging device that is adapted to store a list of other network addresses. As such, DeKonig et al. fails to teach or disclose all elements of claim 1.

Applicant respectfully contends that claim 1, as pending, has been shown to be patentably distinct from the cited reference. As claims 1, 4, 6, 7, and 9 depend from and further define claim 1, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) and allowance of claims 1, 4, 6, 7, and 9.

Claim Rejections Under 35 U.S.C. § 103

Claims 2, 3 and 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DeKonig et al.(U.S. Patent No. 6,769,022). Applicant respectfully traverses this rejection and submits that claims 2, 3 and 12-16 are allowable for the following reasons.

Applicant respectfully maintains, as stated above in regards to the rejection of claim 1, that DeKonig et al. discloses a management station executing and displaying management application programs and not an imaging device having an image generator that is a print engine. Applicant therefore contends that DeKonig et al. fails to teach or suggest all elements of claim 1 from which claims 2, 3 and 12 depend, respectively. Applicant therefore respectfully submits that DeKonig et al. thus also fails to teach or suggest all elements of dependent claims 2, 3 and 12.

In addition, Applicant herein traverses the Examiner taking Official Notice of the “existence of web browsers with printing capabilities” and that therefore a web browser is a print engine. The Applicant disputes this assertion and requests that the Examiner cite to a reference or provide reasoning in support of this position, as the Examiner is required to do by MPEP §2144.03. The Applicant contends that one of ordinary skill in the art would recognize that web browsers as program applications that access across a network to a web server and renders the page returned from the web server on a monitor of the system that it is executing on. Applicant therefore maintains that one of ordinary skill in the art would therefore recognize that web browsers are not inherently print engines. Applicant therefore contends that sufficient information or argument was given in the Applicant’s above arguments to create on its face a reasonable doubt regarding the circumstances justifying any official notice by the Examiner regarding this matter.

In regards to Applicant’s claim 13: Claim 13, as amended, recites, “[a] computer-usable medium having computer readable instructions stored thereon for execution by a processor to perform a method comprising determining a list of network addresses for other imaging devices similar to an imaging device, wherein the imaging device contains a print engine; storing the list of network addresses on the imaging device; and communicating with the other similar imaging devices by referring to the list of network addresses for the other imaging devices.” As detailed above, Applicant submits that DeKonig et al. fails to teach or suggest such a computer-usable medium and method, where an imaging device containing a print engine determines a list of network addresses for other imaging devices similar to the imaging device and stores the list of network addresses on the imaging device. As such, DeKonig et al. fails to teach or suggest all elements of independent claim 13.

In regards to Applicant's claim 15: Claim 15, recites, "[a] method of operating an imaging device, the method comprising determining a list of network addresses for other imaging devices similar to the imaging device, wherein the imaging device contains a print engine; storing the list of network addresses on the imaging device; and referring to the list of network addresses of other imaging devices for communication between imaging devices." As detailed above, Applicant submits that DeKonig et al. fails to teach or suggest such a method of operating an imaging device containing a print engine that determines a list of network addresses for other imaging devices similar to the imaging device and stores the list of network addresses on the imaging device. As such, DeKonig et al. fails to teach or suggest all elements of independent claim 15.

Applicant respectfully contends that claims 1, 13, and 15 as pending have been shown to be patentably distinct from the cited reference. As claims 2, 3, 12, 14, and 16 depend from and further define claims 1, 13, and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 2, 3, and 12-16.

Claims 5 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DeKonig et al.(U.S. Patent No. 6,769,022) in view of Venkatraman et al. (U.S. Patent No. 5,956,487). Applicant respectfully traverses this rejection and submits that claims 5 and 20 are allowable for the following reasons.

Applicant respectfully maintains, as stated above in regards to the rejection of claims 1 and 15, from which claims 5 and 20 depend, respectively, that DeKonig et al. discloses a management station executing and displaying management application programs and not an imaging device having an image generator that is a print engine. In addition, Applicant respectfully maintains that Venkatraman et al. discloses a network device having an embedded web server allowing access to internal functionality and does not teach or suggest an imaging device adapted to store a list of other network addresses, wherein the image generator contains a print engine. *See*, Venkatraman et al., Abstract. Applicant therefore respectfully submits that combining the elements of DeKonig et al. with Venkatraman et al. fails to teach or suggest all elements of independent claims 1 and 15 and thus also fails to teach or suggest all elements of dependent claims 5 and 20, either alone or in combination.

In addition, Applicant herein traverses the Examiner taking Official Notice that the "application 208 (i.e. the controller) comprises an embedded web server" and that "it is well known in the art to provide access to an applet using a web server" and that therefore the

management station 208 of DeKonig et al. that executes and display management application programs to manage storage devices on a network is inherently an embedded web server allowing access to the applets of the management application programs. The Applicant disputes this assertion and requests that the Examiner cite to a reference or provide reasoning in support of this position, as the Examiner is required to do by MPEP §2144.03. The Applicant contends that one of ordinary skill in the art would recognize that the management station 208 of DeKonig et al. executes and displays management application programs for use by an administrator to manage storage devices on a network and therefore initiates and sends commands and requests across the network. The Applicant contends that one of ordinary skill in the art would recognize that web servers respond to commands and requests and do not initiate them. Applicant therefore maintains that one of ordinary skill in the art would therefore recognize that the application of the management station of DeKonig et al. is not an embedded web server. If, alternatively, the Examiner maintains that the application of the management station of DeKonig et al. is inherently an embedded web server, the Applicant respectfully disagrees and herein traverses this assertion, maintaining that no such management station having an embedded web server are disclosed or suggested by DeKonig et al. Applicant respectfully requests that a secondary reference or reasoned statement be provided to support the Examiner's assertion. Applicant respectfully submits that if the Examiner maintains that this is an inherent feature, the Examiner has the burden of proving that the inherent element must of necessity only work in the manner of the Applicant's claimed invention. If any other interpretation is possible for the inherent element relied upon for the rejection, the rejection cannot be maintained. *See*, MPEP §2112 and §2163.07(a). Applicant contends that sufficient information or argument was given in the Applicant's above arguments to create on its face a reasonable doubt regarding the circumstances justifying any official notice or inherency by the Examiner regarding this matter.

Applicant respectfully contends that claims 1 and 15 as pending have been shown to be patentably distinct from the cited reference. As claims 5 and 20 depend from and further define claims 1 and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 5 and 20.

Claims 8, 10, 11 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DeKonig et al.(U.S. Patent No. 6,769,022) in view of Ferlitsch (U.S. Published

Application No. US 2002/0089692 A1). Applicant respectfully traverses this rejection and submits that claims 8, 10, 11 and 17 are allowable for the following reasons.

Applicant respectfully maintains, as stated above in regards to the rejection of claims 1 and 15, from which claims 8, 10, 11 and 17 depend, respectively, that DeKonig et al. discloses a management station executing and displaying management application programs and not an imaging device having an image generator that is a print engine. In addition, Applicant respectfully maintains that Ferlitsch discloses a system for a user to distribute print tasks to a plurality of printers and recover from errors and does not teach or suggest an imaging device adapted to store a list of other network addresses, wherein the image generator contains a print engine. *See*, Ferlitsch, Summary. Applicant therefore respectfully submits that combining the elements of DeKonig et al. with Ferlitsch fails to teach or suggest all elements of independent claims 1 and 15 and thus also fails to teach or suggest all elements of dependent claims 8, 10, 11 and 17, either alone or in combination.

Applicant respectfully contends that claims 1 and 15 as pending have been shown to be patentably distinct from the cited reference. As claims 8, 10, 11 and 17 depend from and further define claims 1 and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 8, 10, 11 and 17.


CONCLUSION

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2207.

Respectfully submitted,

Date: _____

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